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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Naoki KANIE

Group Art Unit: 1795

Application No.: 10/591,026

Examiner: A. CHUANG

Filed: August 29, 2006

Docket No.: 129234

For: FUEL CELL SYSTEM AND METHOD OF CONTROLLING THE SYSTEM

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the April 8, 2008 Restriction Requirement, Applicants provisionally elect Group I, claims 1–7, with traverse.

Applicants respectfully assert that there exists *a priori* unity of invention with respect to claims 1–10, by virtue of the fact that claims 1–10 recite the subject matter of claim 1, as noted in the Office Action.

In regard to claim 10, claim 1 is directed to fuel cell system and claim 10 is directed to a method for controlling a fuel cell system. Thus, claim 1 is directed to a product and claim 10 is directed to the use of the product. Under 37 C.F.R. §1.475(b)(2), an application containing claims directed to a product and a process of use of the product will be considered to have unity of invention. Therefore, the restriction between claim 1 and claim 10 is improper.

In regard to claim 9, there exists *a priori* unity of invention because claim 9 depends from claim 1. As stated in Chapter 10.6 of the ISPE (*International Search and Preliminary Examination Guidelines*):

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

Therefore, claim 9 shares at least each element or technical feature of independent claim 1.

ISPE 10.7 further provides

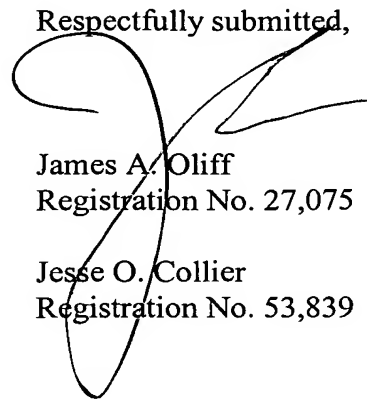
If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. See ISPE 10.7 and 10.8.

The Office Action does not establish that each and every element of independent claim 1 is known in the prior art. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a restriction requirement at this time is improper.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

Respectfully submitted,



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Date: May 2, 2008

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